REMARKS

Claim 18 was objected to based upon a deficiency kindly noted by the Examiner. Accordingly the above amendment is believed to correct for those deficiencies.

Claims 1, 3-5, 10, 12 and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by Fitzpatrick et al. '936 (*hereafter*: Fitzpatrick). The applicant respectfully traverses this rejection for the following reason(s).

Note that in order for an anticipation rejection to be proper, the anticipating reference must disclose exactly what is claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."*Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Note here that the Examiner has not relied on "inherency," accordingly, each and every element must be expressly described in Fitzpatrick.

Claim 1, for example, calls for *a monitor having a screen and a front cover surrounding said screen* and *a fingerprint recognizing module included with said monitor, said fingerprint recognizing module including a fingerprint image recognizing unit* ***disposed on a surface of said front cover.***

Fitzpatrick's fingerprint recognizing module 82 is disposed beneath the screen 44 of the monitor 40. The Examiner refers us to multi-point touch sensitive surface 70, and mistakenly refers to this element as a front cover adjacent the screen referring to col. 4, lines 3-10. Fitzpatrick's col. 4, lines 3-10 do not **disclose** multi-point touch sensitive surface 70 to be a front cover, and the figures do not illustrate where multi-point touch sensitive surface 70 is located.

Looking to col. 3, lines 41-56 and the claims of Fitzpatrick, however, we see that in order to gain access to the system, the user touches one of the items 54, 56, 58, 60, 62, 64, 66 and 68 displayed on the screen and at that point fingerprint recognition is processed. In claim 1, it is stipulated that a user's fingerprint is obtained when a user touches the touch screen.

Accordingly, the multi-point touch sensitive surface 70 is the screen 44, and not a cover.

Additionally, to further clarify the location of the cover, the claims have been amended to stipulate that the cover surrounds the screen as shown in the Applicant's drawings. Note that the drawings may provide basis for the "written description" requirement of 35 USC §112, first paragraph. *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111 (CAFC 1991) states:

"drawings alone may provide a "written description" of an invention as required by §112";

and *Ex parte Holt*, 19 USPQ2d 1211 (BdPatApp & Inter 1991) states:

"[the] invention claimed need not be described *ipsis verbis* in specification in order to satisfy disclosure requirement of 35 USC 112,....since drawings in specification clearly illustrate...[the claimed invention]."

Accordingly, since all the claims require the cover surround the screen, and the art fails to teach this feature, the rejection of claims 1, 3-5, 10, 12 and 17 are is deemed to be in error and should be withdrawn.

Claim 4 also calls for *a microprocessor communicating with a video card in said computer main body*. Fitzpatrick fails to disclose either of the microprocessor communicating and the video card. Here, the Examiner mistakenly refers us to Fitzpatrick's touch driver 74 and graphical user interface 78 as the microprocessor and the video card, respectively.

There is no disclosure in Fitzpatrick that indicates Fitzpatrick's touch driver 74 and graphical user interface 78 are the same as, or equivalent to, a microprocessor and a video card. The configuration of touch driver 74 is unknown. Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

It is well known in the art that a graphical user interface (GUI) is an **integral part of the operating system** (MAC or WINDOWS). Elements of a GUI include such things as: windows, pull-down menus, buttons, scroll bars, iconic images, wizards, the mouse, and no doubt many things that haven't been invented yet.

A video card is a video adapter (alternate terms include graphics card, display adapter, video card, video board and almost any combination of the words in these terms) which is **an integrated circuit card** in a computer or, in some cases, a monitor that provides digital-to-analog conversion, video RAM, and a video controller so that data can be sent to a computer's display.

These elements work together, but are distinct and separate elements of a computer.

Claim 9 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Fitzpatrick. The Applicant respectfully traverses this rejection for the following reason(s).

Claim 9 depends from claim 1 and incorporates the features thereof. Accordingly, claim 9 is deemed patentable over Fitzpatrick for the same reasons discussed with respect to claim 1.

Claim 11 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Harkin '376. The Applicant respectfully traverses this rejection for the following reason(s).

Claim 11 calls for *a front cover surrounding a display screen; a power switch placed on a predetermined portion of said front cover; and fingerprint recognizing means formed integrally with the power switch to read a fingerprint image of a user.*

The Examiner correctly holds that Harkin fails to teach a power switch. Instead, the Examiner indicates that Harkin teaches a "push-button switch placed on a predetermined portion of said front cover." Here, the Examiner refers to element 10, Harkin's sensing array, as the front cover. The Examiner fails to identify, either by reference number or column and line numbers, where Harkin teaches a push-button switch placed on a predetermined portion of sensing array 10.

Looking to Harkin's Figs. 1-9, no push button switch is illustrated as being placed on a predetermined portion of sensing array 10. Sensing array 10 is a flat and transparent and contains no push buttons or push button switches. Sensing array 10 is an integral part of Harkin's display (see figures 6, 7, 8 and 9).

Note, *Ex parte Levy*, 17 USPQ2d 1461, 1462 (1990) states:

> "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

Additionally, since sensing array 10 is an integral part of Harkin's display placing any type of push button switch on a portion of sensing array 10 would reduce the display area of the display. That is, no image could be displayed where a push button switch is located. Accordingly, one of ordinary skill in the art would not have any desire or motivation to include a power switch on any portion of the front cover (sensing array 10) in Harkin.

Also, the claim has been amended to require that the front cover surround the display screen. Harkin's front cover (sensing array 10) does not surround the display screen 70.

Further, Harkins teaches that an **illuminated** push-button switch could be used to operate the fingerprint sensing device, col. 10, lines 29-37, of a very simple kind of display device. Accordingly, power must be supplied to the very simple kind of display device before the push-button switch can be illuminated. Therefore, it would not have been obvious for the illuminated push-button switch to be a power switch.

Accordingly, the rejection of claim 11 is deemed to be in error and should be withdrawn.

Claim 2 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Fitzpatrick and Harkin. The Applicant respectfully traverses this rejection for the following reason(s).

Claim 2 is dependent upon claim 1 and is deemed allowable over the art for the same reasons

as argued with respect to the rejection of claim 1, because Harkin fails to teach the features noted as lacking in Fitzpatrick. Additionally, since sensing array 10 is an integral part of Harkin's display, placing any type of push button switch on a portion of sensing array 10 would reduce the display area of the display. That is, no image could be displayed where a push button switch is located. Accordingly, one of ordinary skill in the art would not have any desire or motivation to include a power switch on any portion of the front cover (sensing array 10) in Harkin.

Also, Harkins teaches that an **illuminated** push-button switch could be used to operate the fingerprint sensing device, col. 10, lines 29-37, of a very simple kind of display device. Accordingly, power must be supplied to the very simple kind of display device before the push-button switch can be illuminated. Therefore, it would not have been obvious for the illuminated push-button switch to be a power switch. Further, Harken fails to identify where the push-button switch would have been located, and suggesting that the push-button switch would have been located on a front cover surrounding a screen of a monitor would rely on hindsight reliance on the teaching of the present application. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)

> One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Accordingly, the rejection of claim 2 is deemed to be in error and should be withdrawn.

Claims 6-8, 13-16, 18 and 19 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Fitzpatrick as applied to claims 1, 3, 5 [and 12], and in further view of O'CONNOR et al. '306 (*hereafter*: O'CONNOR). The Applicant respectfully traverses this rejection

for the following reason(s).

Claims 6-8, 13-16, 18 and 19 depend from claims 1, 3, 5 and 12 and thus incorporate the features noted as lacking in Fitzpatrick. O'CONNOR fails to teach these features, and has not been applied by the Examiner in this regard. Accordingly, claims 6-8, 13-16, 18 and 19 are deemed to be patentable over the applied art for the same reasons as argued with respect to claims 1, 3, 5 and 12.

Note also, that claims 6-8, for example, call for *a decoding unit for decoding the registered fingerprint data read from said fingerprint data base.*

The Examiner has not identified which of the applied references are being relied on for apparently teaching this feature. A review of both references finds no teaching of this feature.

Additionally, claims 6-8 call for *an encoding unit for encoding fingerprint data for storage into said fingerprint data base.*

It appears that the Examiner is relying on O'Connor's encode/compress circuitry 207, however, the encoded signal output from encode/compress circuitry 207 is only applied to decode/decompress circuitry 211, and there is no teaching that the encoded signal output from encode/compress circuitry 207 is stored in memory device 223.

Further, claims 6-8, for example, call for *a fingerprint matching/recording unit . . . for outputting said distinctive feature received from said distinctive feature detecting unit to said encoding unit to be stored as the registered fingerprint data in said fingerprint data base.*

The Examiner correctly notes that Fitzpatrick fails to disclose this feature and relies on O'Connor in this regard by referring to col. 4, lines 43-46, and further referring to analysis circuit 213 and compare circuit 221. In O'Connor's col. 4, lines 43-46 state:

> A memory device 223, which contains electronic signals representative of various "approved" fingerprint signals, is arranged to provide authorized fingerprint signals to the compare circuit 221.

Clearly, the section of O'Connor relied on by the Examiner fails to teach or disclose the foregoing feature of claims 6-8. A further review finds no mention anywhere which suggests encoding distinctive features of a fingerprint for storage in a fingerprint data base. O'Connor's analysis circuit 213 and compare circuit 221 receive decoded fingerprint data from decode/decompress circuit 221 and from memory 223, and output pass or fail (P or F) signals based on the comparison. Looking to each of the drawing figures we find no input to memory 223 indicating that any feature of O'Connor's invention encodes fingerprint data for storage into memory 223.

Claim 14 calls for *determining whether said fingerprint data base has been established in said computer main body prior to determining whether said monitor is a fingerprint recognizing monitor;* and *recognizing that said computer system has been activated and performing fingerprint registration routine when it is determined that said fingerprint data base has not been established, or performing said step of determining whether said monitor is a fingerprint recognizing monitor when it is determined that said fingerprint data base has been established.*

The Examiner has taken Official Notice that the foregoing features are a conventional method of setting up a fingerprint recognizing system because otherwise no one will be able to access the system.

Looking to O'Connor's Fig. 6, a BIOS routine is shown to validate a user entry 601 to the system. Upon initiation, the BIOS is called and the check signature process 603 is run. If there is a wrong mouse return 605, the "Wrong Mouse" message is displayed 607 and the system loops back to the BIOS call 603. If the mouse is correct, a check is made to see if the system designer has designed in a 100% valid feature 609 and if so, a "no signatures on file" message may be displayed 611 and a "pass" message sent to allow entry to the system.

Accordingly, contrary to the Examiner's Official Notice, O'Connor teaches it is not necessary to have an established fingerprint data base to allow access to the system.

MPEP §2144.03 states:

> " The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. In re Ahlert, 424 F.2d 1088, 165 USPQ 418, 420 (CCPA 1970) (Board properly took judicial notice that "it is common practice to postheat a weld after the welding operation is completed" and that "it is old to adjust the intensity of a flame in accordance with the heat requirements."). See also In re Seifreid, 407 F.2d 897, 160 USPQ 804 (CCPA 1969) (Examiner's statement that polyethylene terephthalate films are commonly known to be shrinkable is a statement of common knowledge in the art, supported by the references of record.).
>
> If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. In re Malcolm, 129 F.2d 529, 54 USPQ 235 (CCPA 1942). If the applicant traverses such an assertion the examiner should cite a reference in support of his or her

position.

Therefore, the Examiner should provide a reference in support of the position taken.

Additionally, assuming the Examiner's taking of Official Notice had merit, there is no showing that it must be determined whether the fingerprint data base has been established in the computer main body ***prior*** *to determining whether said monitor is a fingerprint recognizing monitor* as set forth in claim 14.

Claim 14 also calls for *performing a fingerprint registration routine when it is determined that said fingerprint data base has not been established.* Neither reference discloses or teaches the foregoing step as neither reference is drawn to creating a fingerprint data base, but instead they are drawn to fingerprint recognition based on an already established fingerprint database.

Claim 18 calls for, in part, *determining whether a file stored in said computer system is enabled to be encoded or decoded during operation of a file encoding/decoding routine of said computer system.*

The Examiner mistakenly indicates that O'Connor discloses decoding and encoding of fingerprint files and refers us to col. 4, lines 26-32. In O'Connor's col. 4, lines 26-32 state:

> The fingerprint signal may be encoded and/or compressed if desired, by circuitry 207 and applied to additional or other circuitry, or system circuitry including BIOS, for further processing 209. As illustrated by the signal path 209, the fingerprint signature signal being processed for system authorization may be transmitted from the mouse peripheral unit 101 to a main housing 403 as shown in FIG. 4.

Clearly there is no disclosure in the cited section of O'Connor supporting the Examiner's indication that O'Connor discloses decoding and encoding of fingerprint files. The encoding/decoding performed in the cited section is applied to detected fingerprints generated by a first step in the process illustrated in FIG. 2 and includes taking a picture 205 of the fingerprint image 203 resulting from a user applying a fingerprint to and area 201 of the mouse peripheral unit 101.

Claim 19 calls for, in part, *permitting said manager to operate a fingerprint managing and registering program when said comparing step indicates that there is a match between the fingerprint data transmitted from said monitor and the registered fingerprint data output from said fingerprint data base*

Neither reference provides a teaching *fingerprint managing and registering program*, and neither reference teaches permitting a *manager to operate a fingerprint managing and registering program*. The Examiner refers us to O'Connor's col. 4, lines 21-26, which we have discussed above. Clearly this section of O'Connor fails to teach the claimed feature.

Accordingly, the rejection of claims 6-8, 13-16, 18 and 19 is deemed to be in error and should be withdrawn.

The examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

No fees are incurred by the filing of this amendment.

Respectfully submitted,

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